DAC

PATENT
Customer No. 22,852
Attorney Docket No. 01142.0101

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Mark PAUSCH *et al.*	Group Art Unit: 1647
Application No.: 09/786,056	Examiner: S. Wegert
International Filing Date: September 1, 1999	Confirmation No. 6857
For: ENHANCED FUNCTIONAL EXPRESSION OF G PROTEIN-COUPLED RECEPTORS	

Mail Stop Petitions
Director of the U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION TO REVIVE AN UNINTENTIONALLY ABANDONED APPLICATION
UNDER 37 C.F.R. § 1.137(b)

Pursuant to 37 C.F.R. § 1.137(b), Applicants petition to revive this application due to unintentional abandonment. This Petition is accompanied by the following :

1. A copy of a Decision on Petition, mailed May 2, 2006;
2. A copy of a Supplemental Amendment and Request for Reconsideration under 37 C.F.R. § 1.111, submitted June 14, 2006;
3. A copy of a Communication, mailed August 18, 2006;
4. A copy of a Notice of Abandonment, mailed April 5, 2007; and
5. The petition fee of $1,500.

06/11/2007 DEMMANU1 00000126 09786056
01 FC:1453 1500.00 OP

I. No Response Was Required from Applicants and the Application Should Not have been Abandoned For Failure to Reply

This application was subject to three restriction requirements. The third was mailed on April 22, 2003. Applicants timely replied to the restriction requirement in a response filed September 22, 2003. The Restriction Requirement was made final in an Office Action mailed about one year later, on September 23, 2004, in which the Examiner withdrew the claims corresponding to the non-elected groups. Applicants timely responded to the September 23, 2004, Office Action in a response filed March 22, 2005.

The Office mailed a Communication on July 12, 2005, advising Applicants that their Amendment filed March 22, 2005, was not fully responsive because Applicants had not addressed all the claim objections. The Office stated that Applicants had requested that the Office hold in abeyance the claim objections pending the filing of a petition of the restriction requirement, but no such petition had been filed.

On January 11, 2006, Applicants filed a Supplemental Amendment and amended the claims as required by the Communication to cancel non-elected embodiments recited by the elected claims. On January 11, 2006, Applicants also filed a Petition seeking review of the restriction requirement set forth in the Office Action mailed April 22, 2003. The Office mailed a Decision on Petition on May 2, 2006 ("Decision"; Exhibit A). Applicants' Petition was granted-in-part:

> Upon review of the holding [in the Office Action mailed April 22, 2003] it is clear that the holding should, at most, have been considered a request for an election of species, not a Lack of Unity holding, based on the fact that applicants have now claimed specific species within the elected Group which were not previously claimed, and it will be so construed.

> Applicants have complied and elected a species on which prosecution has proceeded. Should the elected species be found allowable over the art, the examiner will follow the guidelines in M.P.E.P. 803.02 for consideration of other species.
>
> * * *
>
> **The application will be forwarded to the examiner for further consideration of applicants' reply and further action not inconsistent with this decision.**

Exh. A, page 3 (emphasis in underlining added).

In view of the Decision, Applicants submitted a Supplemental Amendment on June 14, 2006 (Exhibit B), amending the claims to restore the language under examination before submission of the January 11, 2006, Supplemental Amendment. In accordance with the Decision, Applicants respectfully requested that the Office examine the claims consistent with the elected species, and if found patentable, proceed to examine the further species within the scope of the claims.

The Office responded to Applicant's Supplemental Amendment with a Communication dated August 18, 2006 (Exhibit C). In this Communication, the Examiner asserted that "[t]he new claim set being examined now recites several new inventions." The Communication, however, did not state that a response to this Communication was required and did not provide any deadline for responding. Accordingly, Applicants did not prepare a response.

Applicants received a Notice of Abandonment mailed April 5, 2007 (Exhibit D). The stated reason for abandonment was "failure to timely file a proper reply to the Office letter mailed on 18 August 2006," and that "[n]o reply has been received."

Applicants respectfully assert that no response was required by the Communication of August 18, 2006, and it was improper for the Office to abandon this application.

Furthermore, the Examiner acted contrary to the Petition Examiner's instruction that "[s]hould the elected species be found allowable over the art, the examiner will follow the guidelines in M.P.E.P. 803.02 for consideration of other species." Exh. A, page 3. Applicants amended their claims to recite those other species. Applicants are aware of no authority that prevents them from having claims directed to more than an elected species while the elected species is under examination. Nor did the Examiner cite any authority for the assertion that **only** in the event of allowable subject matter would applicants have been entitled to add additional claims to the non-elected species.

Lastly, the Examiner's contention that "electing claims that recite an invention (or species) and then CHANGING that invention defeats the purpose of the restriction requirement and subsequent examination" (Exh. C) is erroneous for several reasons. Applicants did not change the invention as the elected species remains within the scope of the claims. Adding back the non-elected species is not an impermissible change in claim scope. And it does not impact the subsequent examination, other than to add additional species that must be examined if the elected species is patentable. This is exactly what the Petitions Examiner instructed the Examiner to do.

Rule 1.137(b) requires that a petition to revive for an unintentional delay be accompanied by "[t]he reply required to the outstanding Office action or notice, unless previously filed . . . ." The Communication mailed August 18, 2006, does not advise Applicants that they are required to file a reply. Accordingly, no reply is being filed with

this Petition. If the Examiner maintains that the Supplemental Amendment of June 14, 2006, is somehow improper, Applicants respectfully request that the Examiner issue an Office action setting forth an objection or rejection of the claims, and a period for response, to which Applicants can respond accordingly.

II. The Entire Delay In Responding to the Communication of August 18, 2006, Was Unintentional

In the Communication of August 18, 2006, the Examiner:

1. Did not advise Applicants if the Supplemental Amendment filed June 14, 2006, was entered or not.
2. Did not state that the claims were objected to;
3. Did not state that the claims were rejected;
4. Did not require Applicants to file a response; and
5. Did not set a due date for a response.

Because the Office did not inform Applicants that a response to the Communication of August 18, 2006 was expected, and were not provided a deadline for responding, the entire delay in responding to the August 18, 2006 Communication, including any delay in filing this petition, was unintentional.

III. Conclusion

In view of the above, Applicants respectfully request the revival of this application, and further examination consistent with the Decision mailed May 2, 2006.

If there is any fee due in connection with the filing of this Petition, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 8, 2007

By: _____
Steven P. O'Connor
Reg. No. 41,225 for
James P. Kastenmayer
Reg. No. 51,862

1142-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

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STEVEN P. O'CONNOR
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
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WASHINGTON, D.C. 20001-4413

In re Application of :
Mark Pausch et al :
Serial No.: 09/786,056 : DECISION ON PETITION
Filed: 01 March 2001 :
Attorney Docket No.: 1142.0101 :

This letter is in response to the Petition under 37 C.F.R. 1.144 and 1.181 filed 12 December 2005, requesting review of the restriction requirement set forth in the communication mailed 22 April 2003 and made FINAL in the Office action on the merits mailed 23 September 2004.

BACKGROUND

This application was filed under 35 U.S.C. 371 and accepted on 01 March 2001 and as amended by Preliminary Amendment contained claims 1, 3-4, 6-13, 15-27 and 29-51. On 25 March 2002 a first examiner mailed a Lack of Unity holding to applicants, as follows:

> Group I, claims 1, 3-4 and 6-13, drawn to a yeast host cell containing an active heterologous G-protein coupled receptor;
> Group II, claims 15-27, drawn to a host cell comprising a heterologous G-protein coupled receptor and a mutation host cell gene;
> Group III, claims 29-51, drawn to a host cell comprising a modified G-protein alpha subunit gene.

The examiner also required applicant to elect one of SEQ ID NOs. 1-26 in connection with whichever Group was elected.

Applicants replied on 10 May 2002 electing Group I, but declining to elect a Sequence as such purportedly did not pertain to Group I.

Request for Reconsideration due 7/2/06

dlw 5/4/06

A new examiner set forth a new Lack of Unity holding on 09 September 2002 dividing the claims into 10 groups, as follows:

> Group I, claims 1-12 and 27, drawn to a yeast host cell comprising a heterologous G-protein coupled receptor;
> Group II, claims 13 and 26, drawn to a method of screening compounds that bind to a G-protein receptor to cause cell growth;
> Group III, claims 15-17, drawn to a yeast host cell comprising a mutated gene and a G-protein coupled receptor with improved functional interaction;
> Group IV, claims 15-19, drawn to a yeast host cell comprising a mutated gene and a G-protein coupled receptor which does not interact with desensitization machinery;
> Group V, claims 15-17 and 20, drawn to a yeast host cell comprising a mutated gene and G-protein coupled receptor with reduced degradation;
> Group VI, claims 15-17, drawn to a yeast host cell comprising a mutated gene and G-protein coupled receptor lacking plasma membrane localization;
> Group VII, claims 15 and 21-25, drawn to a yeast cell comprising a mutated gene and G-protein coupled receptor with improved sterol ratios;
> Group VIII, claims 29-44, drawn to a modified G-protein alpha subunit gene;
> Group IX, claim 45, drawn to a modified G-protein alpha subunit protein;
> Group X, claims 46-51, drawn to a method of screening compounds that bind G-protein coupled receptor and gene.

The examiner set forth appropriate arguments for the holding.

On 07 February 2003 applicants responded to this second restriction requirement by electing with traverse the claims of Group II, claims 13 and 26. At this time applicants also amended the claims so that claims 13 and 16 were now independent claims and added new claims 52 - 85, all of which depended from either claim 13 or 26, except for claim 81.

On 22 April 2003 the examiner mailed to applicants a third Lack of Unity holding dividing the claims 13, 26, and 52 - 85 into nine distinct groups which are not set forth herein. The examiner also required an election of species if either Group V or Group IX of the new requirement were elected. The examiner argued that new Groups I-IX, a subset of previous Group II were independent and distinct because they comprised different products which have different characteristics in structure and function.

On 22 September 2003 applicants responded to this third requirement by electing with traverse Group IX, claims 70-80, 82, 83, and 85, and the specific human alpha2A adrenergic receptor. Subsequently, the Office included claims 26 and 52 with the other claims of Group IX. See Office action mailed 23 September 2004, page 2.

On 23 September 2004, the examiner mailed to applicants a first Office action on the merits rejecting claims 26, 52, 70 - 80, 83, and 85. Applicants replied on 22 March 2005.

On 12 July 2005 the examiner mailed to applicants a Notice of Non-Responsive amendment because applicants failed to address the objections advanced in the Office action mailed 23 September 2004.

On 11 January 2006 applicants filed a supplemental amendment in which claims 70 and 80 were canceled and other claims were amended to address the outstanding objections.

On 11 January 2006 applicants filed the instant Petition under 1.144 and 1.181 requesting reconsideration of the third Lack of Unity holding mailed 23 September 2004.

DISCUSSION

Applicants' petition is directed to only the third Lack of Unity holding mailed 23 September 2004 because the examiner has for the first time separated claims 13 and 26 into different inventive groups, whereas in the second Lack of Unity mailed 09 September 2002, the examiner indicated that claims 13 and 26 were in the same group because they possessed the same special technical feature. Applicants cannot understand how claims 13 and 26 and the claims depending therefrom can be separated now into nine groups because they form a single inventive concept under PCT Rule 13.1. Applicants have not changed any limitations in claims 13 and 26 except for making them independent claims.

Applicants' argument has been fully considered. Clearly the making of multiple Lack of Unity holdings in an application is discouraged by the Office. That a second Lack of Unity holding was made is perhaps understandable due to change of examiners, but is not normally done. That the second examiner then made an additional Lack of Unity holding following addition of dependent claims is not conducive to the compact prosecution desired by the Office and applicants. Upon review of the holding it is clear that the holding should, at most, have been considered a request for an election of species, not a Lack of Unity holding, based on the fact that applicants have now claimed specific species within the elected Group which were not previously claimed, and it will be so construed. Applicants have complied and elected a species on which prosecution has proceeded. Should the elected species be found allowable over the art, the examiner will follow the guidelines in M.P.E.P. 803.02 for consideration of other species.

DECISION

For the above reasons, the Petition requesting withdrawal of the third restriction requirement is **GRANTED-IN-PART.** The third Lack of Unity holding is redesignated as an election of species.

The application will be forwarded to the examiner for further consideration of applicants' reply and further action not inconsistent with this decision.

Any request for reconsideration of this decision must be filed within two (2) months of the mailing date of this decision in order to be considered timely.

Should there by any questions regarding this decision, please contact Special Program Examiner, William R. Dixon, Jr. by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.

John L. LeGuyader
Director, Technology Center 1600
wrd

PATENT
Customer No. 22,852
Attorney Docket No. 01142.0101

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Mark PAUSCH *et al.*	Group Art Unit: 1647
Application No.: 09/786,056	Examiner: S. Wegert
International Filing Date: September 1, 1999	Confirmation No. 6857
For: ENHANCED FUNCTIONAL EXPRESSION OF G PROTEIN-COUPLED RECEPTORS	

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Supplemental Amendment and
Request for Reconsideration Under 37 C.F.R. § 1.111

In response to the Decision on Petition mailed May 2, 2006, Applicants submit the following amendments and remarks.

Amendments to the claims are reflected in the listing of claims in this paper.

Applicants' remarks follow the amendment sections of this paper.

AMENDMENTS TO THE CLAIMS:

This listing of claims will replace all prior versions and listings of claims in the application:

1-12. (canceled)

13. (previously presented) A method for screening compounds capable of binding to G protein-coupled receptors, said method comprising (a) subjecting a yeast host cell comprising a constitutively active heterologous G protein-coupled receptor to a test compound; and (b) measuring the effect of the test compound on cell growth.

14-25. (canceled)

26. (currently amended) A method for screening compounds capable of binding to ~~an α2A adrenergic receptor,~~ G protein-coupled receptors, said method comprising (a) subjecting a yeast host cell comprising a constitutively active ~~an α2A adrenergic receptor,~~ heterologous G protein-coupled receptor, and a mutation of a host cell gene that results in an improved functional response of the G protein coupled receptor in a cell-based assay to a test compound; and (b) measuring the effect of the test compound on cell growth.

27-51. (canceled)

52. (previously presented) The method of claim 26, wherein the mutation results in improved agonist stimulated growth promoting ability.

53. (previously presented) The method of claim 26, wherein the host cell gene encodes a regulatory receptor protein kinase, and the mutation causes a reduction in receptor phosphorylation.

54. (previously presented) The method of claim 53, wherein the regulatory receptor protein kinase is selected from the group consisting of G protein-coupled receptor kinases, protein kinase A, protein kinase C and casein kinase.

55. (previously presented) The method of claim 26, wherein the host cell gene encodes a component of the endocytic or degradative pathway and the mutation causes a reduction in receptor sequestration, internalization, or degradation.

56. (previously presented) The method of claim 26, wherein the mutation affects the ratio or nature of sterols in the host cell membrane.

57. (previously presented) The method of claim 56, wherein the host cell gene is selected from the group consisting of *ERG2*, *ERG3*, *ERG4*, *ERG5*, and *ERG6*.

58. (previously presented) The method of claim 57, wherein the host cell gene is *ERG6* and the heterologous G protein-coupled receptor is selected from the group consisting of a human melanocortin receptor, a rat somotostatin SSTR2 receptor, a rat M3 muscarinic acetylcholine receptor, and a rat CCKB receptor.

59. (previously presented) The method of claim 56, wherein the host cell gene is selected from the group consisting of *HEM1*, *HEM3*, *SUT1*, *PDX3*, *UPC1*, and *UPC2* (*UPC20*) and wherein the mutation allows the host cell to grow in the presence of exogenously added sterols.

60. (previously presented) The method of claim 13, wherein the heterologous G protein-coupled receptor is modified at an intracellular domain of the G protein-coupled receptor.

61. (previously presented) The method of claim 13, wherein the intracellular domain is the third intracellular loop.

62. (previously presented) The method of claim 13, wherein the heterologous G protein-coupled receptor is an orphan receptor.

63. (previously presented) The method of claim 61, wherein the heterologous G protein-coupled receptor is an orphan receptor.

64. (previously presented) The method of claim 13, wherein the heterologous G protein-coupled receptor is modified at amino acid residues Asp-Arg-Tyr in the domain proximal to the second intracellular loop of the G protein-coupled receptor

65. (previously presented) The method of claim 60, wherein the modified G protein-coupled receptor is a human alpha 2A adrenergic receptor and the modification comprises a point mutation of threonine to lysine at amino acid residue 373.

66. (previously presented) The method of claim 65, wherein the modification further comprises a truncated third intracellular loop having 44 amino acids.

67. (previously presented) The method of claim 64, wherein the heterologous G protein-coupled receptor is a M3 muscarinic acetylcholine receptor.

68. (previously presented) The method of claim 67, wherein the aspartic acid residue is replaced by a hydrophobic amino acid.

69. (previously presented) The method of claim 68, wherein the hydrophobic amino acid is isoleucine.

70. (currently amended) The method of claim 13 or 26, wherein the host cell comprises a modified G protein alpha subunit gene that encodes a chimeric G alpha protein.

71. (previously presented) The method of claim 70, wherein the modified G protein alpha subunit gene comprises a first nucleic acid sequence encoding the amino

terminal domain of an endogenous G alpha protein, linked to a second nucleic acid sequence encoding the carboxy terminus of a heterologous G alpha protein.

72. (previously presented) The method of claim 70, wherein the modified G protein alpha subunit gene comprises a substitution of a first nucleic acid sequence encoding the five carboxy terminal amino acids of an endogenous G alpha protein for a second nucleic acid sequence encoding the five carboxy terminal amino acid sequences of a heterologous G alpha protein.

73. (previously presented) The method of claim 71, wherein the amino terminal domain of the G alpha protein comprises an interaction domain for a G beta protein, a G gamma protein, and an effector molecule.

74. (previously presented) The method of claim 71 or 72, wherein the modified G protein alpha subunit gene is *GPA1*.

75. (previously presented) The method of claim 71 or 72, further comprising a heterologous G protein-coupled receptor.

76. (previously presented) The method of claim 75, wherein the modified G protein alpha subunit gene is *GPA1*.

77. (canceled)

78. (previously presented) The method of claim 76, wherein the modified *GPA1* gene comprises a first nucleic acid sequence encoding the amino terminal domain of an endogenous G alpha protein, linked to a second nucleic acid sequence encoding the carboxy terminus of a mammalian G alpha protein selected from the group consisting of Gαi2, Gαi3, Gαo, Gαs, Gαq, Gαz, Gα11, Gα12, Gα13, Gα14, Gα15, and Gα16.

79. (previously presented) The method of claim 76, wherein the modified *GPA1* gene comprises a substitution of a first nucleic acid sequence encoding the five carboxy terminal amino acids of an endogenous G alpha protein for a second nucleic acid sequence encoding the five carboxy terminal amino acid sequences of a mammalian G alpha protein selected from the group consisting of Gαi2, Gαi3, Gαo, Gαs, Gαq, Gα11, Gαz, Gα12, Gα13, Gα14, and Gα15, and Gα16.

80. (canceled)

81. (previously presented) A method for screening compounds capable of binding to G protein-coupled receptors, said method comprising:

(a) expressing constitutively active heterologous G protein-coupled receptors in a yeast host cell comprising:

(i) transforming the host cell with a vector comprising a DNA sequence encoding a modified heterologous G protein-coupled receptor, wherein the modification results in a constitutively active G protein-coupled receptor; and

(ii) culturing the transformed host cell to permit expression of the heterologous G protein-coupled receptor.

(b) subjecting a yeast host cell comprising a heterologous G protein-coupled receptor, and a mutation of a host cell gene that results in an improved functional response of the G protein coupled receptor in a cell-based assay to a test compound; and

(c) measuring the effect of the test compound on cell growth.

82. (currently amended) The method of claim 13 or 26, further comprising measuring agonist-stimulated activation of ~~an α2A adrenergic receptor~~ a heterologous G protein-coupled receptor in a host cell comprising:

(a) transforming a host cell comprising a modified G protein alpha subunit gene which encodes a chimeric G alpha protein with a vector comprising a DNA sequence encoding ~~the α2A adrenergic receptor;~~ a heterologous G protein-coupled receptor;

(b) culturing the transformed host cell in the presence of an agonist specific for the ~~α2A adrenergic receptor;~~ heterologous G protein-coupled receptor; and

(c) measuring the growth of the host cell in response to the agonist to determine the agonist-stimulated activation of the ~~α2A adrenergic receptor.~~ heterologous G protein-coupled receptor.

83. (currently amended) The method of claim 13 or 26, further comprising measuring the coupling specificity of a G alpha protein for ~~an α2A adrenergic receptor comprising:~~ a heterologous G protein-coupled receptor comprising:

(a) transforming a yeast host cell comprising a modified G protein alpha subunit gene which encodes a chimeric G alpha protein with a vector comprising a DNA sequence encoding ~~the α2A adrenergic receptor;~~ a heterologous G protein-coupled receptor;

(b) culturing the transformed host cell in the presence of an agonist specific for the ~~α2A adrenergic receptor; and~~ heterologous G protein-coupled receptor; and

(c) measuring the growth of the host cell in response to the agonist to determine the coupling specificity of the G alpha protein for the ~~α2A adrenergic receptor.~~ heterologous G protein-coupled receptor.

84. (previously presented) The method of claim 13 or 26, further comprising measuring agonist-stimulated activation of a heterologous G protein-coupled receptor in a host cell comprising:

(a) culturing a yeast host cell in the presence of an agonist specific for the heterologous G protein-coupled receptor; and

(b) measuring the growth of the host cell in response to the agonist to determine the agonist-stimulated activation of the heterologous G protein-coupled receptor.

85. (currently amended) The method of claim 13 or 26, further comprising measuring the coupling specificity of a G alpha protein for ~~an α2A adrenergic receptor comprising:~~ a heterologous G protein-coupled receptor comprising:

(a) culturing a host cell in the presence of an agonist specific for the ~~α2A adrenergic receptor; and~~ heterologous G protein-coupled receptor; and

(b) measuring the growth of the host cell in response to the agonist to determine the coupling specificity of the G alpha protein for the ~~α2A adrenergic receptor.~~ heterologous G protein-coupled receptor.

86. (new) The method of claim 75, wherein the heterologous G alpha protein is a mammalian protein.

87. (new) The method of claim 77, wherein the heterologous G protein-coupled receptor is selected from the group consisting of rat somatostatin SSTR2, rat adenosine A2a, rat muscarinic acetylcholine M2 and M3, *D. melanogaster* muscarinic acetylcholine M1, rat neurotensin NT-1, human vasopressin V2, rat cholecystokinin CCK-A and CCK-B, human gonadotropin releasing hormone GnRH, human melanocortin MCR4, human

adrenergic α2A, *Aplysia californica* ostopamine OA1, human bombesin receptor related sequence 3 (BRS3), human histamine H3, and human β2-adrenergic receptor.

REMARKS

With entry of this Supplemental Amendment, claims 13, 26, 52-76, 78, 79, and 81-87 are pending in the application.

On January 11, 2006, Applicants filed a Supplemental Amendment in response to the Communication from the Office mailed July 12, 3005. In the Communication, the Office advised Applicants that their Amendment filed March 31, 2005, was not fully responsive because Applicants requested that objections to claims 26, 52, 70-80, 82, 83, and 85 made in the Office Action mailed September 23, 2004, page 4, be held in abeyance. The Office had objected to claims 26, 52, 70-80, 82, 83, and 85 "for reciting or encompassing non-elected inventions (GPCR's in addition to the α2A adrenergic receptor)." The Office also objected to claims 70, 82, 83, and 88 as depending from non-elected claims. To comply with the Communication, In the Supplemental Amendment Applicants amended the claims to the α2A adrenergic receptor as required.

On January 11, 2006, Applicants also filed a Petition seeking review of the restriction requirement set forth in the Office Action mailed April 22, 2003. The Office mailed a Decision on Petition on May 2, 2006. Applicants' Petition was granted-in-part:

> Upon review of the holding [in the Office Action mailed April 22, 2003] it is clear that the holding should, at most, have been considered a request for an election of species, not a Lack of Unity holding, based on the fact that applicants have now claimed specific species within the elected Group which were not previously claimed, and it will be so construed. Applicants have complied and elected a species on which prosecution has proceeded. Should the elected species be found allowable over the art, the examiner will follow the guidelines in M.P.E.P. 803.02 for consideration of other species.
>
> * * *

> **The application will be forwarded to the examiner for firther consideration of applicants' reply and further action not inconsistent with this decision.**

Decision, page 3 (emphasis in original).

In view of the Decision on Petition, Applicants submit this Supplemental Amendment to restore the claims to recite the language that was under examination before submission of the January 11, 2006, Supplemental Amendment. Applicants have entered new claims 86 and 87, which correspond to previous claims 77 and 80. No new matter has been entered into the application.

Applicants have also amended claims 26, 82, 83, and 85. Those amendments to these claims restores the language that existed in the claims prior to submission of the Supplemental Amendment filed on January 11, 2006. The amendments do not enter new matter.

Applicants have also changed the designation of claims 13, 53-69, 81, and 84 from "withdrawn" to "previously presented."

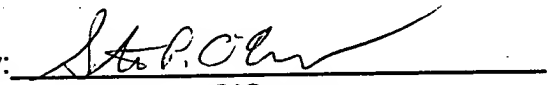
As instructed by the Decision on Petition, Applicants respectfully request that the Office examine the claims consistent with the elected species "α2A adrenergic receptor," and if found patentable, proceed to examine the further species within the scope of the claims.

Applicants do not believe that an Extension of Time is required to obtain entry of this Supplemental Amendment. If this is incorrect, however, please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 14, 2006

By: 

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,056	11/13/2001	Mark Henry Pausch	01142.0101	6857

22852 7590 08/18/2006

EXAMINER
WEGERT, SANDRA L

ART UNIT	PAPER NUMBER
1647	

DATE MAILED: 08/18/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450

09/786,056

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER
	20060816

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The new claim set being examined now recites several new inventions. After the restriction petition was granted-in-part, examination should have proceeded as before, with the proviso that, in the event of allowable subject matter, additional claims would have been added to those being examined. Applicants submitted a new claim set that added to and changed the inventions being examined in pending claims (claims 26, 52, 70-80, 82, 83 and 85). See 37CFR § 1.121(c).

The restriction requirement can be a useful tool for sorting out allowable from non-allowable subject matter, thus often benefitting Applicants. However, electing claims that recite an invention (or species) and then CHANGING that invention defeats the purpose of the restriction requirement and subsequent examination. An acceptable amendment after a restriction requirement is to add new claims that recite additional inventions or species (and will thus be withdrawn until allowance) or to amend elected claims to remove non-elected subject matter.

Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Wegert whose telephone number is (571) 272-0895. The examiner can normally be reached Monday - Friday from 9:00 AM to 5:00 PM (Eastern Time). If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Brenda Brumback, can be reached at (571) 272-0961.

The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLW
14 August 2006

Eileen B. O'Hara

EILEEN B. O'HARA
PRIMARY EXAMINER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,056	11/13/2001	Mark Henry Pausch	01142.0101	6857

22852 7590 04/05/2007
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER	
WEGERT, SANDRA L	
ART UNIT	**PAPER NUMBER**
1647	
MAIL DATE	**DELIVERY MODE**
04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Docketed 4-9-07 Atty RDB/SLO/SPK
Case 01142-0101
Due Date 6-5-07/10 CM/P
Action Action Due
By JD

Notice of Abandonment

Application No.	Applicant(s)	
09/786,056	PAUSCH ET AL.	
Examiner	**Art Unit**	
Sandra Wegert	1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on *18 August 2006*.
   (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
   (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
   (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
   (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
   (d) ☒ No reply has been received.

2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
   (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
   (b) ☐ The submitted fee of $_____ is insufficient. A balance of $_____ is due.
   The issue fee required by 37 CFR 1.18 is $_____. The publication fee, if required by 37 CFR 1.18(d), is $_____.
   (c) ☐ The issue fee and publication fee, if applicable, has not been received.

3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
   (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
   (b) ☐ No corrected drawings have been received.

4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

7. ☐ The reason(s) below:

Eileen B. O'Hara

EILEEN B. O'HARA
PRIMARY EXAMINER

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.